UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,095	08/22/2005	Kimio Ishimaru	4752-004	4555

22429 7590 07/07/2009

LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER	
TROTTER, SCOTT S	
ART UNIT	**PAPER NUMBER**
3694	

MAIL DATE	DELIVERY MODE
07/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/521,095	ISHIMARU ET AL.	
	Examiner	Art Unit	
	SCOTT S. TROTTER	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *11-14,17,18,21 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,15,16,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/29/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Restriction election

1. The Office acknowledges the receipt of Applicant's amendment on April 6, 2009. the office appreciates the pointing out that claim 13 was also withdrawn since it depends from claim 11 which was withdrawn. Therefore applicant elects Group I, claims 1-10, 15, 16, 19 and 20, without traverse. Claims 1-22 are pending. Claims 11-14, 17, 18, 21, and 22 are nonelected. Claims 1-10, 15, 16, 19 and 20 are examined in the instant application. This restriction is made FINAL.

2. In addition this action is made **FINAL**.

Information Disclosure Statement

3. An initialed and dated copy of Applicant's IDS form 1449 filed January 29, 2009, is attached to the instant Office action.

Response to Arguments

4. Applicant's arguments were considered but were not persuasive.

5. Regarding other people saying they can predict the future because they can correctly predict the past which is what is happening when a simulation works on past data. That does not change the Wands factors.

Claim Rejections - 35 USC § 101 Utility

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 2 and 3 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. The conversion mentioned is not sufficient to qualify for the test since it is dealing with predictions which are intangible the same as any other idea.

Claim Rejections - 35 USC § 112, first paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-10, 15, 16, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph. Specifically, one skilled in the art clearly would not know how to use the claimed invention because one skilled in the art would not know what expected results information to use without undue experimentation. Determining expected results appears to be making educated guesses which by definition requires undue experimentation.

The general rule for "Undue Experimentation" is if the factors indicate undue experimentation is required for the use of the invention by considering the a.) breadth of the claims, b.) nature of the invention, c.) state of the prior art, d.) level of one of ordinary skill, e.) the level of predictability in the art, f.) amount of direction provided by the inventor, and g.) the quantity of experimentation needed to use the invention then the claimed invention will be unpatentable. In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988).

i. Here, while the breadth of the claims factor is reasonable because the invention is focused on selling securities. That reasonableness is not sufficient to overcome the scant disclosure regarding how they are predicting the future.

ii. Here, the nature of the invention factor is satisfied because the expected values will vary widely based on the many different methods of determining the expected values and possible assumptions that go into such determinations ie. is the market for cell phones growing, stable or shrinking? Will affect the projections of what a new cell phone projected to capture ten percent of the market will earn. With that ten percent projection being dependent on its own assumptions.

iii. As for the state of the prior art predicting the future has always had a very limited level of success with weather predictions for a couple of days away being relatively dependable but two months or two years away being laughable. Market predictions have not been particularly better or the Ford Edsel and many other products would never have been built.

iv. Here, the level of one of ordinary skill factor is satisfied because most people can not tell a good prediction of the future from a bad prediction of the future until after the fact.

v. Here, the amount of direction provided by the inventor factor is satisfied because the inventor does not rank, prioritize, suggest, or indicate how the expected results will be arrived at. The Application only indicates that expected results will be used, recommendations will be produced and presented to the user without any direction requiring undue experimentation by the user.

vi. Therefore, there is “Undue Experimentation” because all of the factors weigh in to conclude that significantly more experimentation is required based on the facts presented in the application and prior art.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication from the examiner should be directed to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can normally be reached on 8:30 AM – 5:00 PM, M-F.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. The fax phone number for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

sst
7/7/2009

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694